

REMARKS

The Applicant respectfully submits this Amendment And Request For Reconsideration in response to the Office Action of 16 June 2009.

In the present Amendment, the Applicant amends claims 1, 4, 6, 7, 12, 14, 15, 17, 18, 32, and 33, and cancels claim 8; no new claims have been added. The Applicant respectfully requests entry of the amendment and reconsideration of the claims 1-7, 9-22 and 32-34 as revised based on the reasons presented herein.

In the Office Action mailed on 16 June 2009, the Examiner rejected claims 1-12 under 35 U.S.C. § 112, first paragraph. In response, the Applicant respectfully disagrees with these rejections, but nonetheless deletes the language of concern (i.e. "without prompting") in order to reduce the issues and expedite prosecution. Thus, the rejections based on 35 U.S.C. § 112, first paragraph, are now overcome.

In the same Office Action, the Examiner rejected claims 1-22 and 32-34 under 35 U.S.C. § 103(a) as being obvious over Jin (U.S. Patent Application Publication No. US2002/0084888A1) in view of Minborg (U.S. Patent No. 6,977,909). In response, the Applicant respectfully disagrees with the Examiner's rejections, especially in light of the present claim amendments, and submits that all pending claims 1-7, 9-22, and 32-34 as revised are allowable over the prior art for at least the following reasons.

In order for claims to be properly rejected under 35 U.S.C. § 103(a), the prior art in combination must teach or suggest each and every limitation of the claims.

When determining whether a claim is obvious, an examiner must make "a searching comparison of the claimed invention - including all its limitations - with the teaching of the prior art." *In re Ochiai*, 71

F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added). Thus, "obviousness requires a suggestion of all limitations in a claim." *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing *In re Royka*, 490 F.2d 961, 985 (CCPA 1974)).

Ex Parte Wada and Murphy, Appeal No. 2007-3733, Bd. Pat. App. & Inter., January 14, 2008. Because at least one limitation in each claim is not taught or suggested by the Examiner's asserted combination of art, the rejection the claims cannot be maintained.

In the present case, the relied upon art fails to teach or suggest the acts of "reading," "storing," and "repeating" which are performed "automatically" by a mobile station (or more specifically, its processor) "in response to detecting a trigger signal" as claimed in claims 1-7, 9-22, and 32-34. For discussion, the Applicant provides amended method claim 1 below. Method claim 1 recites:

1. A method performed by a mobile station for automatically grouping user-specific information items in a user information file stored in the mobile station, each user-specific information item being for use in identifying or contacting a user of the mobile station, the method comprising the acts of:

detecting, by the mobile station, a trigger signal;

in response to detecting the trigger signal, automatically grouping, by the mobile station, the user-specific information items in the user information file by performing the following acts:

reading, by the mobile station, from a first file stored in the mobile station, a first user-specific information item which is utilized for identifying or contacting the user in a first application of the mobile station;

storing, by the mobile station in the user information file, the first user-specific information item read from the first file;

repeating the acts of reading, by the mobile station, from a second file stored in the mobile station, at least a second user-specific information item which is utilized for

identifying or contacting the user in a second application of the mobile station, and storing, by the mobile station in the user information file, the at least second user-specific information item read from the second file, so that the first and the second user-specific information items are automatically grouped together by the mobile station as user information in the user information file in response to detecting the trigger signal; and after the first and the second user-specific information items have been automatically grouped by the mobile station in the user information file, causing the user information file to be attached in a message for transmission from the mobile station.

As apparent, the recited acts of "reading," "storing," and "repeating" are *indented* to the right of the "automatically grouping" recitation – all of which are performed "in response to detecting the trigger signal." Put another way, the claims are formatted and otherwise fashioned so that the acts of "reading," "storing," and "repeating" *structurally* fall under the purview of the single triggering act.

Thus, proper interpretation thus requires that the acts of "reading" and "storing" of a first user-specific information item, as well as the acts of "reading" and "storing" again (i.e. the *repeating* act) of a second user-specific information item, are performed "automatically" in response to detecting the *single* trigger signal in the automatic grouping.

The Examiner must interpret the claims only as broadly as is reasonable, in accordance with the plain language meaning of terms. The Applicant submits that the plain language meaning of the term "automatic" to those of ordinary skilled in the art is "acting or operating in a manner essentially independent of external influence or control." See e.g. Attachment 1 for a common definition of the term "automatic" from www.freedExceptionary.com. When read in context with the present claims and application, the plain language meaning of the terminology "automatically grouping" which is performed by a "mobile station" or its "processor" means

that the actions are performed in a manner independent of the user of the mobile station. Put another way, it means that the actions are performed without user or manual intervention. This interpretation is consistent with the “automatic grouping” operation described in the specification.

The Applicant has even more narrowly tailored the claim language to clarify that the recited grouping actions are performed “by the mobile station” or “by the processor” (e.g. in contrast to involving intervention by the user). The claim language has also been more narrowly tailored to specify that the “first user-specific information item ... is utilized for identifying or contacting the user *in a first application* of the mobile station” and the “second user-specific information item ... is utilized for identifying or contacting the user *in a second application* of the mobile station.” The storing action is recited to be performed by the mobile station (or its processor) for the user-specific information item that is “read from the ... file.” The above-identified revisions support the interpretation that the grouping is performed by the mobile station or its processor “automatically”, in connection with its internally stored files, in response to detecting the trigger signal, without user intervention.

Given a proper interpretation of the claims, the relied upon art fails to teach or suggest such operation. In the Jin reference, the user is prompted for *manual* (not automatic) user entry or selection of the user data. As apparent from FIGs. 4A-4E of Jin and its description, for example, the prior art teachings require the user to *manually* (not automatically) enter the multiple user data through an application. This is not what is claimed (i.e. this is not “automatically grouping”) and generally illustrates the differences between the relied upon art and that which is claimed. Note that Minborg does not make up for the deficiencies of Jin.

As the relied upon art of the Examiner fails to teach or suggest an “automatic grouping” of user-specific information items in response to

detecting a trigger signal, the rejections should be withdrawn and the claims allowed.

Note further that there would have been no adequate suggestion or motivation to modify the Jin reference to produce that which is claimed. Again, in the Jin reference, it is an important objective that the user be prompted for *manual* (not automatic) user entry or selection of user data. As apparent from FIGs. 4A-4E of Jin and its description, for example, the prior art teachings require the user to *manually* (not automatically) enter the user data through an application. This is not what is claimed (i.e. this is not “automatically grouping”) and generally illustrates the differences between the relied upon art and that which is claimed. In fact, Jin may be viewed as teaching the exact opposite of that which is claimed.

Finally, there is little relationship between the teachings of Jin and the teachings of Minborg relating to the timed “interrupt.” The teachings of Jin relate to the sending of an SMS message with user information. On the other hand, the teachings of Minborg relate to use of timed interrupt for aborting a data download and setting up a voice call. As apparent, there would have been no adequate suggestion or motivation to one ordinarily skilled in the art to utilize a timed interrupt for establishing a voice call for the alternative purpose of automatically initiating a SMS message. There is no relationship between the same, and no indicated reason why these disparate techniques would or should be combined.

Other reasons for allowability of both the independent and dependent claims are apparent to those skilled in the art, but are not detailed herein due to the already-indicated reasons for allowability.

Based on the reasons presented herein, the Applicants respectfully request the Examiner to withdraw the rejections of pending claims 1-7, 9-22 and 32-34 as revised. The Applicants submit that the application as amended is in a condition suitable for allowance.

Respectfully submitted,

/John J. Oskorep/

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